



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Invention: Pole Anchor Footing System)
Serial No.: 10/646,021)
Filed: 8/22/2003)
1 ST Inventor: Ray, Robert)
Examiner: Chapman, Jeanette E.)
Group Art Unit: 3635)
Attorney: Michael S. Neustel)

To: MAIL STOP FEE AMENDMENT
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S RESPONSE TO FIRST OFFICE ACTION DATED MARCH 23, 2004

Dear Sir:

A. PETITION AND FEE FOR EXTENSION OF TIME (37 CFR 1.136(a))

- This is a petition for an extension of the time for a total of One (1) Month to file an Amendment and Response to the outstanding Office Action dated March 23, 2004. The granting of this extension will extend the response time until July 23, 2004.
- 2. Applicant is a small entity that has already been asserted by the Applicant.
- 3. Calculation of the extension fee (37 CFR 1.17(a)-(d)):

Extension Time	Fee (Large Entity)	Fee (Small Entity)
[X] One Month	\$110.00	\$55.00

 A check in the appropriate amount has been included with this response.
 Please charge any insufficiency of fee, or credit any excess, to Deposit Account No. 501248.

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B. APPLICANT'S RESPONSE TO FIRST OFFICE ACTION

Claims 1-20 are pending in this Application with no amendments made. Reconsideration of Claims 1-20 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 of the Official Action

The Official Action rejected Claims 1, 3-11, 13-20 under 35 U.S.C. §103(a) as being unpatentable over Auberlin (U.S. Patent No. 1,164,909) in view of Brown (U.S. Patent No. 1,307,655). The Applicant respectfully disagrees with this rejection of these claims.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a <u>prima facie</u> case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since this is within the capabilities of such a person." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be <u>motivated</u> to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Independent Claim 1 has the following features:

- 1. A pole anchor footing system, comprising:
- a resilient body positionable within a ground surface, said body having a neck portion and a base portion;

wherein said base portion has an **upwardly tapered structure**; and wherein said neck portion is **connectable to a post**.

Independent Claim 11 has the following features:

- 11. A pole anchor footing system, comprising:
- a resilient body positionable within a ground surface, said body having a neck portion and a base portion;
- a plurality of engaging members <u>extending outwardly from said</u> body;

wherein said base portion has an **upwardly tapered structure**; and wherein said neck portion is **connectable to a post**.

Auberlin (U.S. Patent No. 1,164,909) merely teaches a "street stanchion" that has a "tubular casing 1" for slidably receiving a "stanchion or post 9" that allows a "traffic sign [to] be countersunk in the street and easily and quickly raised to an operative position, and to provide novel means for safely housing such a sign when not in use." (See Page 1, Lines 15-20, Lines 58-84). While Auberlin is comprised of a "tubular casing" that is countersunk into pavement, Auberlin does not teach a "resilient body positionable within a ground surface". The term "resilient" means "returning freely to a previous position, shape or condition ... capable of withstanding shock without permanent deformation or rupture ... springy". Webster's Third New International Dictionary at Page 1932 (Copy Enclosed).

More particularly, Auberlin teaches a <u>non-resilient</u> "tubular casing". First, there is no mention of resiliency for the tubular casing in Auberlin. In fact, the disclosure within Auberlin directs one skilled in the art to use a non-resilient tubular casing as there is no purpose to have a resilient tubular casing in Auberlin.

Second, Figure 2 of Auberlin clearly shows the tubular casing solidly secured within the pavement with a "pin" (8) retaining the stanchion in an upright position. In other words, Figure 2 clearly shows that the tubular casing is <u>not</u> designed nor capable of flexing if impacted. If the tubular casing were comprised of a resilient material (e.g. rubber), the stanchion would not be able to slide within the inner lumen of the tubular casing – it is a requirement of Auberlin that it is comprised of a non-resilient material to allow for slidable movement of the stanchion within the same.

Third, Auberlin does <u>not</u> teach a base that is "upwardly tapered". The tubular casing is merely comprised of a straight and non-tapered structure. The structure disclosed within Auberlin is not suitable for usage within various types of ground surfaces (e.g. "sand, wet, soft and the like") as the present invention. A design as shown in Auberlin is susceptible for twisting within the ground surface and uprooting.

Fourth, Auberlin does <u>not</u> teach a "neck portion [that] is connectable to a post". Auberlin merely teaches an elongated passage that receives the stanchion (See Figure 2). The Office Action states that Auberlin teaches a "neck portion above element 6", but this portion is actually contained within the ground surface (See Figure 2) and is merely for receiving the "cap" (4) when the stanchion is retracted into the storage position (i.e. it provides no supporting structure nor is it "connectable to a post").

Fifth, Auberlin does <u>not</u> teach "a plurality of engaging members extending outwardly from said body" as featured within independent Claim 11 of the present

application. The Office Action states that "Auberlin discloses only one engaging member", but the Applicant is unable to locate this alleged "engaging member" – the Applicant respectfully requests clarification of this statement.

Brown (U.S. Patent No. 1,307,655) merely teaches a "collapsible sign and lighting post" for supporting signs and lighting means. It is important to note that Brown "is so constructed as to break or collapse" when "accidentally collided with by [a] vehicle". (Page 1, Lines 19-24). Brown uses a plurality of "panels 15 [constructed] of wood or some other cheap material" to form a tapered structure held together by "wire strands 16" to form a "sheathing" structure. The sheathing collapses when impacted by a vehicle. Hence, the tapered sheathing of Brown simply is not designed for nor is it capable of being positioned within a ground surface. In addition, there is not teaching nor suggestion within Brown to position the sheathing within a ground surface (the purpose is for collapsing, not securing/supporting). In addition, the tapered sheathing of Brown would <u>not provide</u> "a firm and anchored base" as suggested by the Office Action. (Page 3 of Office Action). Finally, the Office Action states that "Brown shows a plurality [of engaging members" - as with Auberlin, the Applicant is unable to locate this alleged engaging members within Brown - the Applicant respectfully requests clarification of this statement.

There is <u>no suggestion or motivation</u>, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art of the present invention, to modify the references or to even combine reference teachings. Auberlin is designed for retractably receiving a stanchion in a slidable manner. Brown is designed for supporting a sign in a collapsible manner <u>above a ground surface</u>.

There is also <u>no reasonable expectation of success</u> of combining Auberlin and Brown. The "sheathing" of Brown is comprised of "<u>thin</u> pickets or panels" which are not suitable (nor capable) of being positioned within a ground surface for resiliently

supporting a post. In fact, Brown is designed to <u>break</u> or <u>collapse</u> – hence, Brown does not teach anything that is resilient.

Finally, the prior art references when combined do <u>not</u> must teach or suggest <u>all</u> the claim limitations of independent Claims 1 or 11 as discussed in detail above. For example, neither reference teaches a "resilient body positionable within a ground surface".

For these reasons, among others, the combination of Auberlin with Brown cannot suggest the combination of features in applicant's Claims 1, 3-11, 13-20, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1, 3-11, 13-20 allowed.

Paragraph 2 of the Official Action

The Official Action rejected Claims 2, 12 under 35 U.S.C. §103(a) as being unpatentable over Auberlin (U.S. Patent No. 1,164,909) in view of Brown (U.S. Patent No. 1,307,655) and Boyd et al. (U.S. Patent No. 5,535,535). The above-stated arguments are incorporated by reference into this section. The Applicant respectfully disagrees with this rejection of these claims.

While Boyd teaches a "breakaway post coupling", there simply is no motivation or suggestion within the references or the art "to employ the coupler of Boyd in order to provide the footing system with an additional function of a break away post." Boyd is designed to be attached between "a ground-mounted stub post" and a "sign-support post". Boyd is actually designed for providing a solution to the problem of posts being broken and would not be suitable for usage with respect to either Auberlin or Brown. For example, how would Boyd attach to the tubular casing of Auberlin? Also, how would Boyd attach to the thin "sheathing" of Brown? There simply is no suggestion to combine these references and if the references were combined they still would not result in the unique features as claimed within independent Claims 1 and 11.

For these reasons, among others, the combination of Auberlin with Brown cannot suggest the combination of features in applicant's Claims 2, 12, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 2, 12 allowed.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,

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Date

July 23, 2004



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with proper postage as First Class mail in an envelope addressed to:

Mail Stop Fee Amendment Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

On July 23, 2004.

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Webster's Third New International Dictionary

OF THE ENGLISH LANGUAGE UNABRIDGED

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residual dextrin n: LIMIT DEXTRIN
residual error n: the difference between a group of values observed and their arithmetical mean residual estate n: RESIDUANY ESTATE
re-Sid-u-al-ly \-15. -3i\ adv ['residual + -ly]: as a residue in a residual manner residual magnetism or residual induction n: magnetization remaining in a magnetized body no longer under external magnetic influence: the magnetism of a permanent magnet residual phenomena n pl: the phenomena that remain to be explained after the effects of known causes are subtracted — compare METHOD OF RESIDUES
residual placer n: a placer deposit consisting of decomposed rock or residual portions of such rock and lying at the locality of origin

explainted ander the enterts of the state of the compared prock of residual places n: a placer deposit consisting of decomposed rock or residual portions of such rock and lying at the locality of origin residual power n: power held to remain at the disposal of a government of a federation alter an enumeration or delegation of specified powers to other authorities (the residual power of the Dominion could not be employed... except in the case of extraordinary national emergency—Alexander Brady)—compare RESERVED POWER residual product n: BY-PRODUCT (coke and coal tar from gasworks are residual products) residual product n: any of the infrared rays that remain in a beam of thermal radiation after a series of reflections from a crystal residual soil n: soil formed in situ by rock decay and left as a residue after the leaching out of the more soluble products residual sound n: echoing sound audible in a place after the source has become silent: REVERBERATION residual Stress n: a stress that exists within a solid body though no external stress-producing forces are acting and that is due to some inequality of previous treatment of adjacent parts (poorly annealed glass may be highly unstable because of residual stresses and shatter from a slight shock) — compare RUPERT'S DROP residual valence n: unemployed valence; esp: combining power that is not utilized when the elements combine to form simple molecules and so leads to such phenomena as association and hydration— compare HYPROGEN BOND THE-Sid-Nary ("Ya"zijo, werle, Te"z-, jan', ji', adj [L residum residue + E-ary]: of, relating 10, consisting of, or constituting a residue, residum, or remainder (the ~ part of an estate) residuary clause n [I residuary]: the part of an estate residuary legage n: a legatee inheriting a testator's will in which the residue of his estate is disposed of to one or more persons — compare BEQUEATH in residuary legaces or in charges against the estate residuary legace n: a legate inheriting a testator's residuary lega

restituary legated n: a legacy that includes an of a testator's estate not specifically distributed in other legacies or in charges against the estate residuary legatee n: a legatee inheriting a testator's residuary estate residuary legatee n: a legatee inheriting a testator's residuary estate residue \(\text{Pres} \) (and \(\text{Pres} \)

of the Church of England to secure resignation of his betterice on some contingency ressignated the contingency ressignation as a mood, pose, or form of emotional indulgence ressignation as a mood, pose, or form of emotional indulgence person (as a writer) devoted to or exhibiting resignationism resigned \(\text{r3}\) '1 at \(\text{given}\) '2'-\(\text{adj}\) [fr. past part. of \(\text{rsigned}\) 1 at \(\text{given}\) 1 at \(\text{given}\) '2'-\(\text{adj}\) [fr. past part. of \(\text{rsigned}\) 1 at \(\text{given}\) 1 at \(\text{given}\) ((he \simma\) vice president) \(\text{2}\) being resigned to something \(\text{circled}\) characterized by resignation: \(\text{subsisted}\) subsisted \(\text{circled}\) vombol \(\text{rsign}\) resignation \(\text{subsisted}\) \(\text{circled}\) \

- re-sign-eu-y \-nose, ...

re-sign-ee \r6\f2\ingrace r\r6\f2\\nabla n - s [resign + -ee] 1: one to whom or in whose favor something is resigned 2: a person who resigns from something (as a job)

re-sign-er \-\f2\fain\r6(r)\n - s [resign + -er]: one that resigns; specif: one that resigns a fee under Scots law — compare

re-sign-ful \-nfol\ adj [resign + -ful] : full of or expressive of

re-sign-ment \-nmont\ n -s [ME resignement, fr. resignen to

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ELECTORY D. 1: capability of a strained body to recover his results of the control o

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ing ceramic materials with washable resist betore applying glaze, luster, or other finish (a pink and bronze ~ jug) (a ~ technique)

re-sist-lance \rangle raizistan(t)s, re-z-\ n -s [ME, fr. MF resistence resistance, fr. LL resistentia, fr. L resistent-, resistens, (pres. part. of resistere to resist) + ia -y 1 1 : the act or an instance of resisting : passive or active opposition; also : a means or method of resisting (unfold to us some warlike ~ ~ Shak.)

2 : power or capacity to resist; esp : the inherent ability of an animal or plant body to resist untoward circumstances (as disease, toxic agents, or infection) — compare IMMUNITY, SUSCEPTIBLITY 3 : an opposing force : a force tending to prevent motion or other action : a retarding force (the ~ of the air to a body passing through it) good ~ to wear) (grade ~ of a railroad) 4a: the property of a body whereby it opposes and limits the passage through it) do a steady electric current — see OHM's LAW; compare ACOUSTIC RESISTANCE b: a source of resistance; specif: RESISTOR 5: the retardation of a boat passing through the water due to (1) the friction between its wetted surface and the water, (2) the making of eddies or dead water, or (3) the formation of waves—called also respectively (1) frictional resistance, skin resistance, (2) eddy resistance, psychoanalysis patient rejects, denies, or otherwise opposes therapeutic efforts by the analyst — compare MECHANISM OF DEFENSE 7 often cap: an organized underground movement of a conquered country made up of groups of fighters engaged in sabotage and secret operations to thwart, waylay, and otherwise wear down occupation forces and often also in punishing collaborators among fellow countrymen — often used with the (a former member of the French ~)

Pessistance box n: an instrument for measuring and comparing electrical resistances

resistance box n: an instrument for measuring and companing electrical resistances resistance coil n: a coil of wire introduced into an electrical circuit to provide resistance resistance derivatives n pl: quantities expressing the variation of the forces and moments on aircraft due to disturbance of steady motion

steady motion
resistance drop n: the voltage drop in an electrical circuit due
to the current traversing a nonreactive resistor — see IMPEDANCE BROP, REACTANCE DROP
resistance furnace n: an electric furnace in which heat is
obtained from the energy loss of a resistor
resistance heating n: heating by means of energy produced by
the passing of electric current through resistance units
resistance point n: a point at which a trend meets with opposing or nullifying forces; esp: the price at which a security on a
declining market tends to stabilize or reverse its downward
trend

resistance thermometer n: a thermometer utilizing a wire as the thermoelectric element and indicating variations in tem-perature by corresponding changes of the electrical resistance of the wire

of the wire resistance welding n: a form of electric pressure welding in which the necessary heat is produced by a flow of current through the parts to be welded and sufficient pressure to make the weld is applied simultaneously with the flow of current—compare BUTT WELDING, PERCUSSIVE WELDING, SEAM WELDING. SPOT WELDING

TRESIST-ANT WELDING, PERCUSSIVE WELDING, SEAM WELDING, SEAM WELDING, SPOT WELDING

Tre-Sist and lalo re-Sist-ent \stant\ adj [resistant fr. MF resistent, resistent, resistent, resistent, presistent or resistere to resist; resistent fr. L resistent-, resistent j = making or having powers of resistance: RESISTING (a constitution ~ to disease) — often used in combination (corrosion-resistant materials)

Tre-Sistant \"\ n - s : one that resists: RESISTER re-Sistant \"\ n - s : one that resists: MESISTER re-Sist-ant-y adv: in a resistant manner: so as to resist resist-dye vi [re-sist] 1: to print (a fabric) by repeatedly putting a resist on different parts of the pattern and placing the fabric in successive dve bails — compare batter 2: to cross-dye (fabric) by weaving with an undyed yarn and a dyed yarn that will resist further dyeing of the completed fabric resisted past of RESIST